

REMARKS

Claims 1-19 are all the claims pending in the application. Claims 1, 3-5, 11 and 15-18 are rejected. Claims 1, 2, 6-10 and 12-14 are objected to but would be allowable if corrections are made. Claims 1, 2, 4, 5, 11, 12, 16 and 17 are amended. New claim 20 is added in order to make clear that air can be included in the bladder with the particles and that the amount of air will have an affect on the characteristics of the element, such as insulation, cushioning and compressibility, as explained at pages 14-16. No new matter is added.

Drawings

The drawings are objected to because the reference number 60 is not shown in the figures. Fig. 1 has been amended to illustrate the presence of the particulate material 60.

Claim Objections

Claims 1, 2 and 12 are objected to because claim 1 refers to “at least one chamber” while the other claims refer to “chambers” or “filling chambers.” These claims have been amended to provide consistency in the reference to “at least one chamber.”

While not the subject of an objection, Applicant has noted that the terminology of claims 16 and 17 are not used in the specification. While such terminology does appear in original claims that form part of the original disclosure, Applicant has amended these claims to use the terminology “ribs” and “partitions” that appear at least at pages 27-29 and 41 with respect to the illustrations in Figs 3, 4 and 13. No new matter is added, and it should be clear that these structures are available for any one or more of limiting motion, establishing cushioning characteristics or influencing the movement of the particles 60.

Claim Rejections - 35 U.S.C. § 112

Claims 3-5 and 11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because of their reference to “the mounting member” and the “secondary object” in a manner that is implicit rather than explicit.

Applicant has amended claims 4, 5 and 11 to make the recitation explicit for these elements.

With respect to claim 3, Applicant disagrees with the Examiner. The language of claim 3 merely specifies the type of object to which the cushioning element may be applied. The element itself is not a part of the claimed combination, in either claim 1 or claim 3, but merely defined for purposes of limiting the environment to which the cushioning element is applied.

Double Patenting

Claims 1-19 are rejected under the judicially created doctrine of obviousness double patenting as being unpatentable over claims 1-9 of USP 6,648,535. This rejection is traversed for at least the following reasons.

Applicant is filing a Terminal Disclaimer in order to remove this basis for rejection.

Conclusion

The present invention as now defined by claims 1-20 concerns a unique, novel and unobvious approach to adding cushioning features to a wide variety of structures, from tools, to sports equipment to medical devices. The use of particulate matter comprising microspheres in air that fill at least one chamber, where the outer wall is flexible and can be kept in a substantially deformed shape after application of pressure, as by hand or other pressing force, which the flexible outer wall assumed during a pressing operation or naturally returns to after removal of the pressure, is a clear basis for patentability.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 CFR 1.111
U.S. Application No. 10/673,468

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

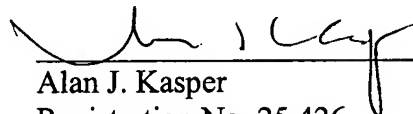
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Alan J. Kasper
Registration No. 25,426

Date: August 30, 2005

Ameridment Under 37 CFR 1.111
U.S. Application No. 10/673,468

AMENDMENTS TO THE DRAWINGS

Figure 1, Replacement Sheet

Attachment: Replacement Sheet(s)